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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/982,482

10/18/2001

Csaba Truckai

CTX-005

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04/28/2004

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

1/

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,482

Applicant(s)

Truckai

Examiner

shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on January 5, 2007
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-18, 21, & 23-48 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18, 21, & 23-48 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yates ('366).

Thermally variable resistive material 39 is interior of thermal conductor 56, which is part of tissue engaging surface 33 (see column 3, lines 44-59 and Figure 16).

Claims 1-7, 9-18, 21, 23, 24, 26, 27, 29-45 and 47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Panescue et al in view of Picha and Pacific Silk.

Panescue et al teach a device such as claimed, including a tissue contacting surface (elements 24) and a supporting body which can be made from silicone rubber (see element 22, column 8, 122 and line 50-55) and can be impregnated with a conductive material (see e.g. column 19, lines 5-16). Picha teaches that silicone belongs to a longer class of silicone compounds known as silicone polymers (see column 4, lines 15-16) and Pacific Silk teaches that silicone rubber, with a resistivity as taught by TABLE 3 of Panescue et al (see column 19) have a carbon density of about 12%, which is in the range disclosed by applicant (see the instant disclosure, page 17, first full

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sentence). Thus the references to Picha and Pacific Silk highlight the inherency of the claimed behaviors in the material disclosed by Panescue et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson in combination with Swanson et al. Swanson teaches a device such as claimed, but does not teach the use of foam. Swanson et al teach a device as claimed except for the use of carbon particle. It would have been obvious to the artisan of ordinary skill to employ carbon in the foamed polymeric matrix of Swanson et al since the doped and undoped polymers can be employed equivalently, as taught by Swanson, or to use a foam in the device of Swanson since foamed and non foamed polymers are equivalents, as taught by Swanson et al, thus producing a device such as claimed.

Claims 8, 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescue et al in combination with Yamoda et al and Giller et al. Panescue et al teach the use of thermistors. Yamoda et al teach that thermistors can be compound of Zirconia. Giller et al show that zirconia is zirconian oxide. It would have been obvious to the artisan of ordinary skill to a thermistor as taught by Yamoda et al, since Panescu et al teach no particular thermistor material, thus producing a device such as claimed.

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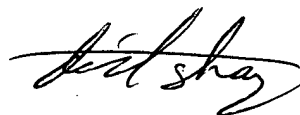
Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescua et al in combination with Swanson. Panescu et al teach a device such as claimed except for the use of DC. Swanson teaches the equivalence of AC and DC as tissue affecting energy. It would have been obvious to the artisan of ordinary skill to employ DC rather than SC in the device of Panescu et al, since these are equivalents, thus producing a device such as claimed.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al in combination with Takehana et al. Jones et al teach an electrosurgical probe that is used with an endoscopic. Takehana et al teach endoscopes using a pressure sensitive conductive ink to control the bending thereof. It would have been obvious to the artisan of ordinary skill to employ the device of Jones et al with the endoscopes of Takehana et al, since the device of Jones is intended with a variety of endoscopes, or to employ the pressure sensitive ink and bending mechanism of Takehana in the device of Jones et al, since this would radically simplify the mechanism of Jones et al, thus producing a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

March 22, 2004



DAVID M. SHAY
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GROUP 330